IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1915.

No. 1[redacted]111

NATIONAL BRAKE & ELECTRIC COMPANY,
Petitioner,

vs.

NIELS A. CHRISTENSEN AND ALLIS-CHALMERS COMPANY,
Respondents.

BRIEF OF RESPONDENTS IN REPLY TO PETITION AND BRIEF FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

JOSEPH B. COTTON,
WILLET M. SPOONER,
LOUIS QUARLES,
WILLIAM P. RUMMLER,
Solicitors and of Counsel for Respondents.

ance of said decree of said District Court for the Eastern District of Wisconsin, and remanding said cause to the said District Court with directions for the dismissal by the last mentioned court at the costs of the plaintiff of the said bill of complaint brought against it by said Christensen and Allis-Chalmers Company in the United States District Court for the Eastern District of Wisconsin, Equity Number 474;—said suit being recited in said application or petition to be the same suit which was pending in said Circuit Court of Appeals upon the appeals of the National Brake and Electric Company as No. 2163 of the October Term, 1913, from the interlocutory decree of said District Court enjoining said defendant National Brake & Electric Company from infringing patent No. 635280, as appeared by the transcript upon said appeal then remaining in said court.

By stipulation between counsel for the respective parties, appearing of record herein, it was provided that the record on said application of petitioner in said Circuit Court of Appeals should consist of the petition to the Circuit Court of Appeals, and the answer thereto, and copies of certain portions or excerpts from the testimony, pleadings, decrees, master's reports, etc., in the cause No. 474 in the District Court for the Eastern District of Wisconsin and in the causes in the Circuit Court of Appeals for the Third Circuit and in the District Court for the Western District of Pennsylvania, all of which are in the record herein on this certiorari as returned in obedience to said writ.

Said application by petition was heard by the Circuit Court of Appeals for the Seventh Circuit and denied and said petition or motion of petitioner was dismissed by an order of that court on April 29, 1919, at which time

an opinion was rendered by said court which placed its decision solely on the position that for the purposes of determining the rights of the parties, the decree of the District Court for the Eastern District of Wisconsin entered August 21, 1914, and affirmed by the Circuit Court of Appeals, October 5, 1915, sustaining said patent No. 635280 and finding infringement and ordering an accounting, was a final decree and not an interlocutory decree.

Second. That on June 2, 1919, this petitioner, The National Brake & Electric Company, presented to this court a petition for a writ of certiorari from this court to the United States Circuit Court of Appeals to review its said judgment order of April 29, 1919, and supported the same by setting forth in said petition the facts necessary for a consideration of the petition and the grounds on which said petition was based, and also by a brief filed with the said petition upon the questions therein involved. The said plaintiffs Niels A. Christensen and Allis-Chalmers Company filed with this court on the said day a brief made up of a "Statement of Facts" and an "Argument" in opposition to the issuance of said writ of certiorari.

On consideration thereof, this court on June 9, 1919, granted a certiorari which was duly issued and obeyed by the Circuit Court of Appeals of the Seventh Circuit, said cause being No. 382 on the docket of this court.

The said cause, as your petitioner submits, of the *National Brake and Electric Company* v. *Niels A. Christensen and Allis-Chalmers Company*, No. 474 in Equity in the District Court of the Eastern District in Wisconsin, and No. 2163 in Equity in the Circuit Court of Appeals of the Seventh Circuit, is now, therefore, before this court on and for the purposes of said certiorari. And the

petitioner represents that the record herein returned b
said Circuit Court of Appeals in obedience to said wr
of certiorari shows exactly the state of facts on whic
the petitioner founded its application to the Circuit Cou
of Appeals for the Seventh Circuit in August, 1918, an
on being overruled there its application for a certiora
to this court.

Third. The petitioner on the granting of the ce
tiorari by the Supreme Court as aforesaid,—being a
vised and believing that by its own force and effect th
said certiorari so issued by this court operates to an
does stay until the decision of the cause by this court, th
further proceedings in both the Circuit Court of Ap
peals for the Seventh Circuit in Number 2163 on th
docket of said court and in the District Court of th
United States for the Eastern District of Wisconsin i
No. 474 in Equity on the docket of that court (being
each case the suit or litigation between said Christe
sen and the Allis-Chalmers Company on the one pa
and The National Brake & Electric Company of the oth
concerning their rights under patent 635280, as afor
said),—brought to the attention of the Honorable Fer
nand A. Geiger sitting as judge in the United Stat
District Court for the Eastern District of Wisconsin, a
of Harry L. Kellogg, Esq., the master in cha
cery before whom the said accounting before describ
is proceeding, the issuance of said certiorari and r
quested them to stay the accounting and the further p
ceedings in said cause until this court should have hea
and decided the cause so pending on certiorari before

But the said Honorable Ferdinand A. Geiger as st
judge of the District Court aforesaid and the s
Harry L. Kellogg, Esq., master in chancery as afo
said, declined and refused to further stay said proce

ings or order said proceedings or accounting to be stayed as requested, and the Honorable Ferdinand A. Geiger treating said suggestion of this petitioner as a motion to the said District Court of the Eastern District of Wisconsin to stay further proceedings under the decree in said cause, denied the same and rendered an opinion in doing so, expressing his conclusion as follows:

> "It may be conceded as quite elementary that ordinarily the issuance of a writ of certiorari carries with it a supersedeas. But I cannot escape the conviction that the judgment which is the subject of the present proceedings in this court is not at all affected, either by the petition filed in the Circuit Court of Appeals, nor by the certiorari issued by the Supreme Court. Such petition filed three years after the Circuit Court of Appeals had exhausted its appellate jurisdiction—and the latter was the only jurisdiction ever invoked—is clearly of the nature of an original proceeding and in my judgment, particularly in view of the refusal of the Court of Appeals to grant the relief prayed for, reaches neither the judgment nor this court."

Fourth. Conceiving that it might be proper, considering the judgment of October 5, 1915, of the Circuit Court of Appeals for the Seventh Circuit affirming the decree of the District Court of the United States for the Eastern District of Wisconsin entered on August 21, 1914, and the fact that the writ of certiorari from this court had been directed to said Circuit Court of Appeals, to apply to the said Circuit Court of Appeals for the Seventh Circuit for a direction to the District Court of the Eastern District of Wisconsin to stay proceedings in the said accounting under said decree, the petitioner The National Brake & Electric Company made such an application by motion before said Circuit Court of Appeals on October 7, 1919, at the coming in of said court for the October Term thereof. The said Circuit Court of Ap-

peals holding that since the issuance of the certiorari, it had no longer any jurisdiction over said cause or application, denied the said motion for such want of jurisdiction.

Fifth. The petitioner now moves this court, by writ of prohibition or other proper writ, direction or order, to direct the said Honorable Ferdinand A. Geiger, judge of the District Court of the United States, for the Eastern District of Wisconsin, and Harry L. Kellogg, Esq., master in chancery as aforesaid, to stay the further accounting in said cause of *Christensen* v. *The National Brake & Electric Company*, and any further proceedings in said cause under the decree rendered by the said District Court in said cause on August 21, 1914, until the further order of this court or the decision by this court of the cause, *The National Brake & Electric Company* v. *Niels A. Christensen and Allis-Chalmers Company*, No. 382 on the present docket of this court, for the following reasons:

(a) That such stay is the legal effect of the said certiorari issued as before set forth and described, and that the said Honorable Ferdinand A. Geiger and the said Harry L. Kellogg, Esq., master in chancery, have refused to take notice of and abide by said certiorari and the legal effect thereof, and

(b) That if such stay of the said accounting and further proceedings in said cause, be not as the petitioner is advised and believes it to be, the effect by its own force of the certiorari before described, issued by this court on June 9, 1919, it is respectfully asked that this court should exercise its power and discretion to direct such stay in furtherance of its jurisdiction and in order to make effective the certiorari which it has ordered and

by virtue of which the said cause is before this court for consideration and decision.

Should this court deem that it is the proper course of proceeding in such a case as this to move for leave to file a petition for a writ of prohibition or other proper writ or order, then the petitioner asks that this motion or application shall be regarded and taken as such application for leave to file a petition for such writ of prohibition or other writ or order, and that an order granting such leave be made.

Respectfully submitted,

NATIONAL BRAKE & ELECTRIC COMPANY,
Petitioner.

By THOMAS B. KERR,
CHARLES A. BROWN,
Its Solicitors.

JOHN S. MILLER,
EDWARD OSGOOD BROWN,
Of Counsel.

IN THE

SUPREME COURT OF THE UNITED STATES,

October Term, A. D. 1919.

No. 382.

National Brake & Electric Company,
Petitioner,

vs.

Niels A. Christensen and Allis-Chalmers Company,
Respondents.

BRIEF IN SUPPORT OF THE PRECEDING MOTION.

In compliance with our understanding of the rule of this court, we have incorporated in our written motion or petition submitted herewith, a statement of the facts and the objects of the motion—and there is little to add thereto, as we conceive. It would be superfluous to attempt an argument addressed to this court on the general effect of a certiorari issued by it to an inferior court in any given cause, whether that court is the intermediate and appellate tribunal or a court of original jurisdiction in which the litigation which is the subject of the certiorari, originated.

On this point, this court is, of course, the interpreter of its own process, mandates and orders. We can only submit to this court that which we submitted to the District Court of the Eastern District of Wisconsin, that it certainly is the general rule that a writ of certiorari from

this court is in and of itself a supersedeas in the litigation in which it is issued until this court has disposed of the subject matter and contentions involved in it. This has been hitherto invariably recognized by the inferior federal courts, as we believe, when the question has been raised. When the certiorari from this court has been directed to the Circuit Courts of Appeal, those courts have, as did in the instant case the Circuit Court of Appeals for the Seventh Circuit, declined—because their hands were tied and their jurisdiction of the case for the time lost by the certiorari—to make any direction to the court in which the litigation originated. But they have coupled frequently with that refusal and declination a statement that the certiorari was *proprio vigore*, a supersedeas and direction to the lower court to proceed for the time no further with the litigation.

Thus the Circuit Court of Appeals of the Ninth Circuit in *Waskey* v. *Hammer, et al.*, 179 F. R., 273, said, speaking of a certiorari issued to it by this court:

> "It would seem upon principle in view of the effect of the writ and consequent stay that all proceedings in this court *as well as in the District Court of Alaska* to which the mandates of this court were issued, are stayed until the decision of the Supreme Court shall be rendered upon its review of the judgment of *this court, and that notice of the issuance of the writ should be brought to the attention of the District Court in order that it may direct a stay of further proceedings*, and that *this* court is powerless to act in the premises."

And in *Louisville N. A. & C. Ry. Co.* v. *Louisville Trust Co., et al.*, 78 F. R., 639, the Circuit Court of Appeals of the Sixth Circuit, in declining to set aside because of a certiorari from this court an order of dismissal it had made, said:

> "It (the certiorari), however, suspends any further act by the Circuit Court of Appeals *or by the*

trial court in obedience to the adjudication of the Circuit Court of Appeals, after the writ has been awarded or at least when the court is notified of the issuing of the writ of certiorari by the Supreme Court and its service upon the Circuit Court of Appeals."

And in *Bailey* v. *Lansing*, 13 Blatchford, 424, Judge Wallace in the Circuit Court of the Northern District of New York said that the decisions are uniform that:

> "Upon the allowance of a certiorari the effect of a judgment which it is taken to review *except* in the *single case of an execution already issued and in process of being executed* is suspended as to all proceedings under it *and as to all collateral matters.* The judgment is not even evidence in a case between the same parties. It is as completely suspended as though it had never been rendered."

And the Circuit Court of Appeals of the Seventh Circuit in deciding against us in the instant case, the application which *ex majori cautela* we made to it for direction to the District Court, placed its decision not on any difference in view as to the effect of a certiorari nor on any supposed or technical distinction between the cause in which the certiorari was issued and that in which we desired the proceedings stayed, but solely on the want of jurisdiction after the certiorari had been granted by this court, to issue any instruction or direction to the District Court in the cause involved. It reminded us properly enough that it was the jurisdiction of this court and the effect of the process of this court we were invoking, and that to this court, therefore, must be referred the protection of its own jurisdiction and the effect of its own process when ignored by any subordinate court.

Nor did the learned judge of the District Court in refusing to order a stay of proceedings in the litigation fail to recognize the general effect of a supersedeas. The

passage from his opinion, which we have quoted in the written motion prefixed, distinctly shows such recognition. "It may be conceded as quite elementary," he said, "that ordinarily the issuance of a writ of certiorari carries with it a supersedeas."

But he places his refusal entirely upon the theory that our application of August 19, 1918, to the Circuit Court of Appeals was "clearly of the nature of an original proceeding and * * * particularly in view of the refusal of the Court of Appeals reaches neither the judgment nor this court."

We understand him in this statement to mean by "the judgment" the decree of the District Court of August 21, 1914, finding the patent 635280 valid and infringed and ordering an accounting. On the theory of the learned judge thus presented, we may, therefore, perhaps be justified in briefly commenting.

Our application to the Circuit Court of Appeals on August 19, 1919, was not "an original proceeding" in any such sense as the district judge conceived. The District Court's conception that it was an original proceeding assumed that the view of the Circuit Court of Appeals of the Seventh Circuit that the decree of the District Court in Wisconsin, and its own order of affirmance, were final and not interlocutory, is to be accepted. This conception, for the purpose of this certiorari, its scope and its effect as a stay of proceedings, is clearly a mistaken one. The said application sought the vacation of a decree maintained to be interlocutory because of a final decree thereafter entered in another court which constituted a positive bar and defense to the suit in which the interlocutory decree had been entered and was a proceeding in the same suit. We made such application to

the Circuit Court of Appeals. This was because the affirmance and mandate of the Circuit Court of Appeals stood in the way of a successful issue of any such application originating in the District Court although it might be carried for review to the court above. In that sense only, that is, as distinguished from an appeal or writ of error, the application or proceeding was "original" in the Circuit Court of Appeals, but certainly not in the sense that it was an "independent," "disconnected," "separate" or "new" suit.

The petition and proceeding in the Circuit Court of Appeals, which is under review on this certiorari, was entitled and made in the case No. 2163, *National Brake and Electric Company, Appellant* v. *Niels A. Christensen and Allis-Chalmers Company, Appellees,* which was an appeal from the District Court in Wisconsin, in which the Circuit Court of Appeals had entered its judgment affirming the decretal order of the District Court in the suit of said appellees as plaintiffs against said appellant as defendant, adjudging letters patent No. 635280 to be valid and enjoining said defendant, National Brake Company, for the term of said patent. Said petition or motion in the Circuit Court of Appeals was further entitled:

> "In the matter of the application of National Brake and Electric Company for an order directing the dismissal of the bill of complaint brought against it by said plaintiffs in the United States District Court for the Eastern District of Wisconsin, In Equity No. 474, and for a stay of proceeding in the District Court until application is heard and determined."

And such was its nature and purpose. It was as clearly directed to the setting aside of said decree of the District Court sustaining the patent and to the dismissal of the bill as was the appeal which had formerly been taken in the same case to the Circuit Court of Appeals. It was

based on the ground that the decree of the District Court and the judgment of the Circuit Court of Appeals affirming the same were respectively interlocutory and not final and, therefore still in the breast of the court. Under and in view of the ruling of the Supreme Court in *In re* Potts, 166 U. S., 263, and other cases, deciding that although such a decree of a trial court be interlocutory, yet after it has been reviewed by an Appellate Court, the trial court cannot without leave of the reviewing Appellate Court proceed to enter an order or decree inconsistent with the mandate or reviewing order of the reviewing court, the application was made directly to the Circuit Court of Appeals.

The record on which it was presented was made up by stipulation by copies of everything in the instant case and in the Pennsylvania case that bore on the question presented, and the "instant case" was the suit brought by Christensen (joining the Allis-Chalmers Company) against the National Brake and Electric Company in the District Court of the Eastern District of Wisconsin, carried on appeal by the National Brake & Electric Company to the Circuit Court of Appeals for the Seventh Circuit—and there decided against our client in what we maintain was an order affirming an interlocutory decree of the District Court and, therefore, itself interlocutory but which the plaintiff maintains was a final order or affirmance affirming a final decree of the District Court.

To treat the motion and application to the Circuit Court of Appeals as an "independent" or separate or disconnected or new suit in which the certiorari issued by this court can have no effect upon the District Court and the decree (which we contend was interlocutory) of that court in Bill in Equity No. 474, seems to us, therefore, with all respect to the learned judge of that court who so holds, erroneous, un-

reasonable and inadmissible. It was a substantive part of that case, and, therefore, it seems to us that the certiorari of this court issued to the Circuit Court of Appeals by its own force and vigor, operated or should operate as a supersedeas in that court until this court shall have decided the contentions involved, and that because when brought to the attention of the District Court and its officers, that proper effect and operation have been denied to it, we are justified in asking directions to allow them.

And, indeed, if the certiorari issued from this court does in the opinion of this court not *proprio vigore* act as a supersedeas in the Wisconsin District Court when brought to its attention, we ask in our petition that it should exercise its indubitable power to issue the process we pray for, to protect under the circumstances of this case, its jurisdiction and its process.

By issuing the certiorari in question, this court by implication held that the question involved and our contention in the case presented were matters "open to controversy" (Lau Ow Bew Petitioner, 141 U. S., 583), "weighty and serious" (*In re* Woods, 143 U. S., 202), and that the issuance of the certiorari was necessary "to prevent extraordinary inconvenience and embarrassment in the conduct of the case." (*American Construction Company* v. *Jacksonville Railway*, 148 U. S., 372.)

The case in right reason stands as though this court were considering on appeal the original decree and affirmance with the additional factor which did not exist at the time of their rendition that there has been a final decree in the Pennsylvania court holding patent 635280 void; and with the additional factor that this court, upon looking into the record, has granted the certiorari.

An elaborate and expensive accounting with an infinity

of details is going on under the direction of the District Court in Wisconsin. If the contentions of the defendant to the suit (the applicant here) for the summary stoppage of this litigation, because of developments and judicial action in another jurisdiction subsequent to the decree ordering the accounting, are correct, then the labor and time given to the further accounting will be futile and wasted. Moreover, if those contentions are correct, they strike at the very basis of the litigation, and everything done under the decree of the District Court in Wisconsin will, so far as it is possible to accomplish it, have to be undone, set aside and rectified. If the accounting is not to be stayed until this court has passed on the "weighty and serious matter"—"open to controversy" and likely to produce "extraordinary inconvenience and embarrassment," there is no line that can be drawn as to what should be stopped under that decree in the way of sequestration, execution and enforcement.

If the accounting and subsequent proceedings are to go on as uninterruptedly as if the Supreme Court had not taken this matter involving the whole merits and essence of the controversy into its consideration (precisely as though it had been carried there by appeal), we cannot see what "embarrassment and inconvenience in the conduct of the case" would be avoided. If they are stayed, such embarrassment and inconvenience may well be avoided.

If the Circuit Court of Appeals on our application had ruled the other way and held the decree of the Wisconsin court interlocutory and that of the Pennsylvania court final, had acceded to our request and instructed the District Court to vacate the reference on the order for the accounting, to vacate its decree holding 635280 a valid patent, and to dismiss the bill, or to do any one or

more of these things—and plaintiffs Christensen *et al.* had sought and obtained a certiorari from this court, there would have been no question that by that certiorari these affirmative acts which the District Court had been instructed to perform would have been stayed until this court had decided the case.

The learned judge of the District Court, when declining to stay proceedings under the present certiorari, so conceded. He placed the distinction upon the fact that in the one case the Circuit Court of Appeals would have recalled a mandate binding on the District Court—in the other it would not have done so. If this does create a distinction in the actual legal effect of the certiorari, which we cannot believe, it creates no distinction as to the expediency and justice of a stay during the consideration of the cause by this court. In essence the difference in the situation makes more expedient and just such a stay in the actual than in the hypothetical case. An order of the Circuit Court of Appeals vacating the accounting already had or dismissing the bill might, on final decision the other way by this court, be in its turn vacated and the *status quo ante* restored without expense or "extraordinary inconvenience and embarrassment." But that is palpably not the case with the *prosecution* of the proceedings which this court may on consideration of the record now before it hold erroneous, futile and improper.

Therefore, it is that we ask, that even if this court should not hold that by its own inherent nature and force the certiorari demands a stay of the proceedings in the Eastern District of Wisconsin, it nevertheless would in its discretion direct such stay by the prohibition prayed for, or such other writ, direction or order as may be appropriate in the furtherance of justice and in the protection of its jurisdiction.

Our motion here finds authority in *Bronson* v. *La Crosse Railroad Company*, 1 Wallace, 405, as in accordance with the practice of this court. And we have no doubt that if this court concludes and should indicate that the proceedings in the District Court should be stayed as was done in the Bronson case, the distinguished judge of that court would need nothing further, and that no writ or formal order would be called for.

Respectfully submitted,

THOMAS B. KERR,
CHARLES A. BROWN,
Solicitors for The National Brake & Electric Co.

JOHN S. MILLER,
EDWARD OSGOOD BROWN,
Of Counsel.

IN SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1919.

No. [redacted]111

NATIONAL BRAKE & ELECTRIC COMPANY,
Petitioner,
vs.
NIELS A. CHRISTENSEN and ALLIS-CHALMERS COMPANY,
Respondents.

Certiorari to the United States Circuit Court of Appeals for the Seventh Circuit.

BRIEF IN OPPOSITION TO MOTION FOR WRIT OF PROHIBITION AND STATEMENT OF FACTS CONCERNING SAID MOTION.

JOSEPH B. COTTON,
WILLET M. SPOONER.
WILLIAM B. RUMMLER,
LOUIS QUARLES,
Solicitors and of Counsel for Respondents.

SUBJECT INDEX.

INDEX OF CASES CITED.

IN SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, A. D. 1919.

No. 382.

NATIONAL BRAKE & ELECTRIC COMPANY,
Petitioner,

vs.

SIELS A. CHRISTENSEN *and* ALLIS-CHALMERS COMPANY,
Respondents.

Certiorari to the United States Circuit Court of Appeals for the Seventh Circuit.

BRIEF IN OPPOSITION TO MOTION FOR WRIT OF PROHIBITION.

STATEMENT OF FACTS.

This is a motion by the petitioner for a writ of prohibition directed to the United States District Court for the Eastern District of Wisconsin and its Master in Chancery, and is entitled in a matter pending in this court on certiorari issued to review a judgment of the United States Circuit Court of Appeals for the Seventh Circuit denying the relief sought by an original petition filed therein by the petitioner herein as petitioner therein. That petition was filed by the petitioner August 19, 1918, in the Circuit Court of Appeals for the Seventh Circuit and set up that an accounting proceeding was pending in certain patent litigation in the District Court for the Eastern District of Wisconsin (known as Equity 471), pursuant to a decree of said District Court and a mandate of affirmance thereof by the Court of Appeals October 5, 1915, almost three years prior, and demanding that the

Court of Appeals direct the District Court not only to refuse to proceed further with said suit but to determine it on the merits in favor of petitioner and dismiss the bill because of certain judgments entered in its favor by the District Court of the United States for the Western District of Pennsylvania, and the Circuit Court of Appeals for the Third Circuit.

The suit thus sought to be ended was a suit then and now pending in the said District Court of the United States for the Eastern District of Wisconsin, known as Equity 474; the respondents are plaintiffs therein and the petitioner is defendant. It is a suit in Equity, for infringement of a grant of patent monopoly right evidenced indifferently by two patents numbered 621,324 and 655,280 respectively (called the first and second patents respectively). It appeared that the first patent when issued to respondent Christensen was inaccurate, in that it contained a fugitive sheet of drawing. He thereupon returned it to the patent office with the request that a correction thereof be made, and that was done by the office marking the patent cancelled and issuing to him a second patent identical in every respect with the first patent except only the omission of the fugitive sheet and the date and term thereof. (Rec. p. 87).

The District Court after trial by a decree, entered on August 21, 1914, found that respondent Christensen was the owner of a valid patent, that it was infringed, and ordered a perpetual injunction and an accounting (Rec. p. 39). The decree for convenience in terms referred to the second patent. The court in its opinion did not deem it material which of the patents evidenced the grant, but said:

> "Whether the patent be evidenced by one, the other or both, is not, in view of the issues now before material * * * the question, upon the present state of the case, is therefore, academic only" (Rec. p. 34).

This decree was affirmed by the United States Circuit Court of Appeals on appeal (No. 2163), October 5, 1915, the court saying in its opinion:

> "It is no moment which of the two patents be held to be in force. The surrender for cancellation of the one was conditioned upon the grant of a valid legal substitute. If the Commissioner of Patents was without authority to issue the second, then, in our judg-

ment, his action in cancelling the first must be deemed legally ineffective * * *. This is a case of pure clerical error not of double patenting. While two documents have been issued, there is but a single grant of one and the same right to the same person" (Rec. p. 44).

A petition for certiorari was denied Feb. 21, 1916 (241 U. S., 659).

The District Judge further placed himself on record as to the basis of his decree of August 21, 1914, and the academic nature of the reference therein to the second patent, saying:

> "I may say, preliminarily, that, when the substance of things is considered, there was no reason why the interlocutory decree entered by this Court should have categorically answered the question, whether Patent Number 635,280 is a valid patent. My own judgment is that the Bill did not tender that issue * * *. * * * It cannot be gainsaid that, had the decree of this Court recited the ultimate facts relative to the issuance of the two paper documents, and then adjudged that the grant evidenced by the identical claims of the two was valid and infringed, the decree would have been an entirely proper one, and, certainly, more in consonance with the Bill and the record in the case (Rec. p. 248).

Thereafter, and on March 4, 1916, the record was returned to the District Court with the mandate of the Circuit Court of Appeals and on that date an accounting commenced before Harry L. Kellogg, Esq., as Master and has proceeded so far that he rendered his final report therein on the 26th day of March, 1919, complete in all respects excepting only certain clerical computation of figures which he directed petitioner's accountants to do forthwith.

After this court's denial of the writ of certiorari in 1916 respondents commenced an action based on the same patents against Westinghouse Traction Brake Company. Before filing an answer therein the patents expired leaving only the questions of accounting, and in view of the fact that no notice of infringement was claimed to have been given to the Traction Brake Company and that the marking was solely under the second patent, the Court of

Appeals for the Third Circuit decided that the defendant was entitled to a judgment on the bill and answer as to which of the two patents was the valid evidence of the grant, and found in favor of the first patent, directed the case to proceed to trial in the District Court thereon, and to be dismissed as to the second patent No. 635,280 only (Rec. p. 113). No decision has ever been rendered on the merits of the first patent.

On this state of the record in these two cases an original petition was filed in the Circuit Court of Appeals for the Seventh Circuit in the nature of a motion for writ of prohibition or an application for bill of review directed to the District Court and commanding it to dismiss the accounting then pending in the aforesaid original case, Equity No. 474, upon the merits because of an alleged conflict between the judgment of the Court of Appeals in the Third Circuit and the Court of Appeals in the Seventh Circuit, claiming that the Third Circuit had held that the second patent was void, that the proceedings in the Seventh Circuit were founded solely thereon, and that they should therefore fall because of *res adjudicata*. This claim was based on the allegation of privity between the defendants in the two actions, which was and is strenuously denied and which question has never been determined by either the District Court or the Court of Appeals.

An answer was filed to this petition and the issues made thereon were submitted to the Court of Appeals upon a record consisting of excerpts from pleadings, decrees, testimony, etc., in the cases in both the Seventh and Third Circuits, and it is that record which has been transmitted to this court on the writ of certiorari.

This petition for determination of the litigation was made about three years after the expiration of the term at which the affirmance of the decree of August 21, 1914 was made; and no part of that proceeding commenced in the District Court and known as Equity 474 was or for years had been pending in the Court of Appeals.

Since the denial of this original petition, petitioner has applied to the District Court in Wisconsin for an order staying proceedings which has been refused. It has also applied to the Court of Appeals for the Seventh Circuit with a similar result. Inasmuch as reference ha

been made in the petition and annexed brief to the opinion of the District Judge on this motion, we take the liberty of annexing a copy thereof as Appendix A to this brief.

OUTLINE OF ARGUMENT.

1. The judgment of the Circuit Court of Appeals to review which this court issued its writ of certiorari, was rendered in a suit commenced in that court by original petition and pending therein on petition, answer, and stipulated record.

2. A writ of certiorari operates to remove the record in the suit and to the court to which addressed and therefore incidentally acts as a stay of proceedings; but such stay is limited to the court and suit the record in which is sent up in the return to the writ.

3. The return to the writ of certiorari issued by this court brought up for review the petition, answer, and record in the Court of Appeals in the original proceeding therein and that alone.

4. As the accounting proceedings now by this motion sought to be stayed never were pending in the Circuit Court of Appeals, this court secured no jurisdiction thereover and consequently the writ does not operate as a stay therein.

5. The proper method to obtain a review of the decree of the Court of Appeals was by appeal to this court as that decree was not made final by the provisions of the Judicial Code. Certiorari will not lie thereto and should therefore be dismissed.

6. A writ of prohibition or mandamus will not lie to stay the completion of patent accounting proceedings merely because a question of law which may ultimately effect the accounting proceedings is pending before this court for decision on certiorari.

7. The extraordinary remedy of prohibition will lie only to review want of jurisdiction in a lower court. It will not lie to review the exercise of a judicial function by an inferior tribunal, nor is a motion of this kind proper.

8. Petitioner will not be benefitted by the staying of the accounting, but on the contrary, respondents will be irreparably damaged thereby.

ARGUMENT.

I.

THE JUDGMENT OF THE CIRCUIT COURT OF APPEALS TO REVIEW WHICH THIS COURT ISSUED ITS WRIT OF CERTIORARI, WAS RENDERED IN A SUIT COMMENCED IN THAT COURT BY ORIGINAL PETITION AND PENDING THEREIN ON PETITION, ANSWER AND STIPULATED RECORD.

The proceeding in the Circuit Court of Appeals for the Seventh Circuit to which the writ of certiorari from this court was addressed was not pending on a writ of error or appeal of any kind or description, but was an original proceeding commenced therein by original petition praying a judgment directing the District Court of Wisconsin to cease further litigating a cause then pending in said District Court on the claim that all the issues therein had been disposed of by a judgment rendered in the Third Circuit. The issues were framed by pleadings made up in that court, to-wit: petition and answer, both duly verified, and the record was made up of excerpts from the proceedings in the divers litigations claimed to be in conflict. No part of the record was made up by transmittal to that court of the record in any cause pending in the District Court in Wisconsin.

An analysis of the petition addressed to the Court of Appeals shows conclusively that it initiated an original and independent proceeding.

The petitioner asked the court for an order directing the District Court to dismiss the aforesaid suit pending below, on the following grounds: "This motion is based upon the ground that all of the issues in the case have been fully and finally determined and adjudicated in said defendant's favor by the United States Circuit Court of Appeals for the Third Circuit and by the final decree of the District Court for the Western District of Pennsylvania in the suit between the said plaintiffs and the Westinghouse Traction Brake Company, with which company this said defendant was in privity" (Rec. p. 2).

The prayer in the petition is similarly framed, reciting:

> "This applicant and petitioner moves and prays * * * that this Honorable Court take jurisdiction * *

hereof and inquire into and determine the status of said case as herein outlined, and as to the force and effect of said final judgment and order in the said suit in the District Court for the Western District of Pennsylvania, and find and adjudge that the same was and is a valid and final adjudication against said patent, No. 635,280, and that the said patent last mentioned was and is invalid and void: (similar allegations that the first patent had been adjudged void in equity 474) * * * and that this defendant is entitled thereon to a final decree in said suit in the District Court for the Eastern District of Wisconsin, dismissing said suit for want of equity; * * * (Rec. p. 5).

The prayer continues and asks that necessary writs of certiorari, etc., be issued to carry out the demands of the petitioner.

The Court of Appeals for the Seventh Circuit took the same view of the petition that we do and in their opinion they state:

> "And now petitioner comes before us *in an original proceeding*, asking that we recall our mandate, vacate our decree, find that the Pennsylvania decree is *res adjudicata* in this case, and thereupon direct the vacation of the Wisconsin decree and the dismissal of the bill on the merits" (Italics ours) (Rec. pp. 256-7).

The learned counsel for petitioner in their petition to this court for the writ of certiorari took the same position, for that petition states the proceeding was an "original proceeding entitled as above, *National Brake & Electric Company, Petitioner, v. Niels A. Christensen and Allis-Chalmers Company, Respondents*: An application for an order directing dismissal of the bill brought in the United States District Court for the Eastern District of Wisconsin." (Petition p. 10).

It is further stated in the petition "that the said Circuit Court of Appeals in denying the said application or motion placed its decision solely on the position that for the purposes of determining the rights of the parties and of constituting the basis of a plea on claim of res adjudicata the decree * * * was a final decree and not an interlocutory decree." (Petition p. 6.) To the same effect, see allegations p. 8 thereof. Furthermore it is set forth in the said petition

that no question of jurisdiction or practice arises because "the Circuit Court of Appeals took jurisdiction of the application, considered the same as an original proceeding * * * and decided the same as before set forth solely on the question of the final or interlocutory nature of the decree of the Wisconsin District Court." (Petition p. 9.)

On a motion for stay of proceedings in the accounting case in the Eastern District of Wisconsin made to District Judge Geiger the question was sharply presented, elaborately argued, and the Judge reached the same conclusion, holding that the writ of certiorari did not stay the proceedings because the writ issued to and reviewed only the independent suit commenced and pending solely in the Court of Appeals. See Appendix A.

The petition was lodged in the Court of Appeals about three years after it had rendered its decision and sent down its mandate affirming the validity of respondent Christensen's patent, and the term had long since expired. It must be conceded that the power of the Court of Appeals over its mandate expired with the expiration of the term at which it was rendered:

Waskey et al. v. Hammer, etc. Co., 179 Fed., 273 (C. C. A., 9th Cir.)

Westinghouse T. B. Co. v. Orr, 252 Fed., 592 (C. C. A., 3rd Cir.)

and therefore the Court of Appeals could entertain the petition, if at all, solely as an original proceeding, not a proceeding in aid of its appellate jurisdiction, for that had been exhausted, neither was it in aid thereof but was contrary thereto and was therefore addressed to it originally.

Neither does the nature of the petition to the Court of Appeals and the proceedings instituted thereby depend for its character upon the finality or lack of finality of the previous decree and mandate of that Court. Whether the decree be final or interlocutory is not material in considering the nature of the proceeding. In either event jurisdiction over the decree was lost by the expiration of the term and equally in either event the relief prayed for was based not on the record in the suit but facts *dehors* that record. The petition therefore was in the nature of an application for a bill of review.

The point is attempted to be made by counsel for petitioner because they attached to the title to the petition "No. 2163," which was the number given by the Court of

Appeals to the previous appeal in the case. We submit that the mere caption or title placed upon the petition by petitioner itself, cannot change the inherent nature of the proceeding. It is like Lincoln's famous saying about the lamb with five legs which was extant if the tail was called a leg, that "calling it a leg don't make it a leg." If any reliance is to be made upon captions and titles we think the only conclusion to be deduced therefrom is in our favor in that the authority which is petitioner's sole reliance—*In re Potts*, 166 U. S., 263, was not entitled in the action, to-wit: *Potts v. Craeger*. That was as this is, an independent proceeding addressed to an appellate tribunal in the nature of a request for leave to file a bill of review and based upon facts happening *puis darrein continuance*.

II.

A WRIT OF CERTIORARI OPERATES TO REMOVE THE RECORD IN THE SUIT AND TO THE COURT TO WHICH ADDRESSED AND THEREFORE INCIDENTALLY ACTS AS A STAY OF PROCEEDINGS: BUT SUCH STAY IS LIMITED TO THE COURT AND SUIT THE RECORD IN WHICH IS SENT UP IN THE RETURN TO THE WRIT.

It is elementary that the function of the writ of certiorari is to remove the record from the court to which addressed to the court issuing the writ. This was done by the return to the writ. When the record is removed from the court it follows that that court loses jurisdiction of that matter in so far as it is dependent upon the record. A court cannot proceed without a record before it and when the record is transmitted to a higher court the jurisdiction of the lower court is for the time being transferred to and vested in the appellate tribunal.

As a necessary consequence of this rule the power of the lower court over the particular proceeding is suspended and therefore the writ of certiorari has the incidental effect of a stay.

The result of the granting of the certiorari was to remove from the Court of Appeals the record then in that court on the original petition, and we frankly concede that it had the effect of a supersedeas in that proceeding and in that court for the reason that it removed the record therefrom and transferred it to this court. The authorities abundantly support this proposition and the reason underlying it. Thus in

Ewing v. Thompson, 43 Pa. St., 372,

the court, speaking through Judge Strong, afterwards Justice of the United States Supreme Court, said:

"On the same day a *certiorari* was sued out of this court by the complainant to remove the record of the contest in the court of Quarter Sessions, and it was served. The effect of that writ was to stay further proceedings in the court below, and to remove the record of the case into this court. That such is the effect of a *certiorari*, except in cases where the legislature has made a different rule, is the doctrine of all the cases. It is not itself a writ of supersedeas, but it operates as one by implication. Originally in fact, and now always in theory, at least, it takes the record out of the custody of the inferior court, and leaves nothing there to be prosecuted or enforced by execution."

Also in

Neuman v. State, 76 Wis., 112,

it has been held:

"The effect of the issuing and serving of the writ is not to open or vacate the judgment or action of the inferior tribunal, like an appeal giving a new trial upon the merits, but merely to remove the records thereof to the superior court for inspection, and thus enable such court to determine whether the inferior tribunal had the rightful jurisdiction or the rightful authority to render such judgment or perform such act."

In

Commonwealth v. Kistler (Pa.), 24 Atl., 216,

the court said:

"The writ of certiorari, as said by Strong, J., in *Ewing v. Thompson*, 43 Pa. St., 372, 'is not in itself a writ of *supersedeas*, but it operates as one by implication,' because it takes the record out of the custody of the inferior court, and leaves nothing there upon which to proceed. If anything remains outstanding and not removed, then action upon such matter is not superseded. * * * *The suspensory power of the writ, therefore, arising merely by consequence, from the removal of the record, it operates only on the court and parties directly connected with the proceedings.* Action by other parties and upon collateral matters is not interfered with. * * *"

The effect of a writ of certiorari therefore is, by re-

moving the record from the court to which addressed, to tie its hands and prohibit it from taking any further action therein. Matters in that court and in that proceeding therein are to remain *in statuo quo ex necessitate rei.* That rule has been distinctly laid down and applied in a case almost if not entirely analogous to the case at bar in the decision so strongly relied on by petitioner in the proceeding instituted by it by petition in the District Court (before Judge Geiger), to-wit:

Waskey v. Hammer 179 Fed., 273 (C. C. A., 9th Cir.)

That involved an action of trespass commenced in the District Court of Alaska. An appeal was taken to the Circuit Court of Appeals and after the rendition of its judgment and issuance of its mandate a writ of certiorari was granted by the Supreme Court from the decision of the Court of Appeals. A motion was then made in the Court of Appeals asking that it recall its mandate so as to vacate the proceedings in the District Court. The court held that it had no power to do this, that the granting of the certiorari operated to stay the hand of the Court of Appeals and it could not issue any order to the District Court effecting the litigation in any way whatever.

There is this distinction between the case cited and this case as regards the proceedings in the court below. In the Waskey case the matter was pending in the Court of Appeals on an appeal from the District Court decree and that decree was therefore before the Court of Appeals for review, consequently the writ being addressed to the Court of Appeals having that decree *in gremio,* reached the decree itself and therefore stayed it everywhere. In the case at bar the certiorari was issued in an original proceeding commenced in this court by the filing of a petition and the decree of the District Court under which the accounting is proceeding was not before this court. On the contrary, this court was asked to *take* jurisdiction over that decree and refused to do so. The distinction is clear and decisive.

That being so the certiorari operated to remove from the Court of Appeals to this court merely the record of that original proceeding and did not disturb or in any wise affect the record pending in the District Court. This question was disposed of by the Circuit Court of Appeals for the Seventh Circuit on an application of the petitioner for an order from that court staying the accounting which

they denied for want of jurisdiction and for the aforesaid reasons. See also

Ex parte Wagner, 39 Supt. Ct. Rep., 317;
—U. S.,— (Decided April 14/19.)

III.

THE RETURN TO THE WRIT OF CERTIORARI ISSUED BY THIS COURT BROUGHT UP FOR REVIEW THE PETITION, ANSWER, AND RECORD IN THE COURT OF APPEALS IN THE ORIGINAL PROCEEDING THEREIN AND THAT ALONE.

The record in the matter now pending before this court on certiorari was, as heretofore stated, made up by verified petition, answer, and record. That and that alone was sent to this court in obedience to the writ of certiorari. The pleadings, etc., on that proceeding are set out, Record p. 1 et seq., and the writ issued by this court referred to a suit

> "in which National Brake & Electric Company is petitioner and Niels A. Christensen and Allis-Chalmers Company are respondents,"

and directed that court to remit "the record and proceedings in said cause" (Rec. p. 265).

The accounting proceedings now sought to be reached by this motion did not form a part of said proceedings in the Court of Appeals, and they were pending solely before the District Court. That fact was clearly brought out by the Court of Appeals for the Seventh Circuit when petitioner requested that court to issue a stay to the District Court pending the hearing on the aforesaid certiorari. That was denied because it had not pending before it the accounting proceedings or any part thereof. The accounting had been strenuously litigated for about four years since the rendition by the Court of Appeals of its opinion affirming the validity of the patent on October 5, 1915 (229 Fed., 564), (Rec. p. 41) and the voluminous record therein made up was not lodged with the Court of Appeals nor did it as such form a part of the record therein; nay more, the accounting proceeding continued to be litigated during all the time the original petition was pending in the Court of Appeals and petitioner herein even took steps therein after the issuance of this writ of certiorari.

The record in the accounting proceeding has at all times been and now remains with the District Court. It was never sent to the Circuit Court of Appeals and has never been and is not now in this court, consequently this court has as yet no jurisdiction thereover.

IV.

AS THE ACCOUNTING PROCEEDINGS NOW BY THIS MOTION SOUGHT TO BE STAYED WERE NEVER PENDING IN THE CIRCUIT COURT OF APPEALS, THIS COURT SECURED NO JURISDICTION THEREOVER AND CONSEQUENTLY THE WRIT DOES NOT OPERATE AS A STAY THEREIN.

From what we have shown it is apparent that the accounting proceedings always have been and still are pending solely in the District Court for the Eastern District of Wisconsin. Neither that suit, nor any part thereof, was ever transferred to the Circuit Court of Appeals for the Seventh Circuit and consequently none of the record of that proceeding ever found its way to this court. It follows therefore *a fortiori* that this court has secured no jurisdiction thereover and that the writ of certiorari does not run thereto. Consequently the effect of the writ as a stay of proceedings does not apply thereto as those proceedings are not sought to be here reviewed. The only proceedings sought to be reviewed by this writ are as stated by petitioner, the petition of the Court of Appeals on the questions of general law, i. e., finality of its prior order and mandate, and the effect of the plea of *res adjudicata*. No accounting proceedings are involved and no patent questions appear. They are purely questions of practice and of general law.

The question of the effect of the writ upon the extraneous accounting proceedings in an independent court was presented to and passed upon by Judge Geiger in his opinion heretofore adverted to (Appendix A) who analyzed the proposition and disposed of it as follows:

> "It may be conceded as quite elementary that ordinarily the issuance of a writ of certiorari carries with it a supersedeas. But I cannot escape the conviction that the judgment which is the subject of the present proceedings in this court, is not at all af-

fected, either by the petition filed in the Circuit Court of Appeals, nor by the certiorari issued by the Supreme Court. Such petition, filed three years after the Circuit Court of Appeals had exhausted its appellate jurisdiction,—and the latter was the only jurisdiction ever invoked,—is clearly of the nature of an original proceeding, and, in my judgment, particularly in view of the refusal of the Court of Appeals to grant the relief prayed for, reaches neither the judgment nor this court.

* * * * *

It has seemed to me that whatever the character of the petition filed in the Court of Appeals, the situation in this court so far as affected by that petition and its attempted review by the Supreme Court, is no different than if the declared purpose had been to obtain leave of the Court of Appeals to file a supplemental bill in the nature of a bill of review in this court,—based upon the proceedings in the Third Circuit. If in such situation the Appellate Court refused leave, it could hardly be said that a certiorari to its ruling reached the judgment which, under the original mandate then rested in the District Court for exclusive enforcement."

The logic of this analysis is we submit ineluctable.

V.

THE PROPER METHOD TO OBTAIN A REVIEW OF THE DECREE OF THE COURT OF APPEALS WAS BY APPEAL TO THIS COURT AS THAT DECREE WAS NOT MADE FINAL BY THE PROVISIONS OF THE JUDICIAL CODE. CERTIORARI WILL NOT LIE THERETO AND SHOULD THEREFORE BE DISMISSED.

Where the decree of the Circuit Court of Appeals is not made final by the terms of The Judicial Code it is reviewable by this court by appeal. Section 241 of the Code provides:

> "Sec. 241. In any case in which the judgment or decree of the circuit court of appeals is not made final by the provisions of this Title, there shall be of right an appeal or writ of error to the Supreme Court

of the United States where the matter in controversy shall exceed one thousand dollars, besides costs."

The cases in which decrees of the Court of Appeals are made final are found in Section 128 of The Judicial Code, pertinent portions of which are:

> "Sec. 128. The circuit courts of appeals shall exercise appellate jurisdiction to review by appeal or writ of error final decisions in the district courts, * * * *; and, except as provided in sections two hundred and thirty-nine and two hundred and forty, the judgments and decrees of the circuit courts of appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy being aliens and citizens of the United States, or citizens of different States; also in all cases arising under the patent laws, under the copyright laws, under the revenue laws, and under the criminal laws, and in admiralty cases."

Certiorari will lie only to review "the judgment or decree of the Circuit Court of Appeals (in cases wherein it) is made final by the provisions of this Title."

(Sec. 240 The Judicial Code.) That section provides:

> "Sec. 240. In any case, civil or criminal, in which the judgment or decree of the circuit court of appeals is made final by the provisions of this Title, it shall be competent for the Supreme Court to require, by certiorari or otherwise, upon the petition of any party thereto, any such case to be certified to the Supreme court for its review and determination, with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court."

An analysis of the petition addressed to the Court of Appeals shows that it raises two questions only: (1) the finality or interlocutoriness of its previous judgment, and (2) the effect of certain judgments in the third circuit as *res adjudicata*. These are all questions of general law. They are not even patent questions. That being so the proceeding is not "a case arising under the patent laws" within the purview of section 128 of The Judicial Code and therefore the decree of the Court of Appeals was not made final by the provisions of the code. Consequently a writ of certiorari is not the proper remedy, but appeal is.

That certiorari will not lie to review the judgment

from which an appeal may be taken is established by the following cases:

Denver v. New York Trust Co., 229 U. S., 123, 133.

Farrell v. O'Brien, 199 U. S., 89, 101.

Dana v. Dana, — U. S., — (39 Sup. Ct. Rep. 449) (June 2, 1919).

That controversies raising questions of practice and *res adjudicata* only, even though they may ultimately influence patent litigation, are not "cases arising under the patent laws" is also equally well settled.

Pratt v. Paris Gas Lt., etc. Co., 168 U. S., 255, 259.

Cook v. Beecher, 217 U. S., 497.

New Marshall Engine Co. v. Marshall Engine Co., 223 U. S., 473.

For these reasons we submit that the writ of certiorari was not the proper remedy for petitioner to elect to bring this cause before this court, and therfore it is without jurisdiction thereover and the writ should be dismissed.

Simultaneously with the service of this brief a printed motion to dismiss for want of jurisdiction and brief in support thereof has been served and filed in accordance with the provisions of Subdivision 4 of Rule 6, so that that matter is expending.

VI.

A WRIT OF PROHIBITION OR MANDAMUS WILL NOT LIE TO STAY THE COMPLETION OF PATENT ACCOUNTING PROCEEDINGS MERELY BECAUSE A QUESTION OF LAW WHICH MAY ULTIMATELY EFFECT THE ACCOUNTING PROCEEDINGS IS PENDING BEFORE THIS COURT FOR REVISION ON CERTIORARI.

Mandamus or prohibition will not lie to compel the District Judge to stay an accounting proceeding therein because of the pendency of a writ of certiorari.

Respondents rely in support of this proposition upon the recent decision of this court in

Ex parte Wagner, 39 Sup. Ct. Rep., 317, — U. S., —. (Decided April 14/19.)

That was a case almost on all fours with the present

se. The present action was begun in 1906. The decree
lding the patent valid and infringed was affirmed by
e Court of Appeals October 5, 1915 (Rec. p. 41) and
tition for certiorari was denied by this court February
, 1916. (241 U. S., 659.) The record was transmitted
the Honorable Harry L. Kellogg on March 4, 1916, and
immediately commenced the accounting proceeding in
hich a great mass of testimony has been taken, with the
sult that on March 26, 1919, he filed his final report
mplete in all respects excepting only as to certain cler-
l computation which he directed to be done, and which
uld have been done ere this had not petitioner stopped
e work thereon.

It was held in the *Matter of Wagner, supra*, that man-
mus would not be granted by this court to stay the
ent accounting where the District Court was called
on and did determine judicially the scope of the deci-
n of the Circuit Court of Appeals and forecast as best
might the scope and effect of the decision of this court
on the rights of the parties and exercised its discretion
permit the continuance of an accounting which had
en strenuously litigated for four years. The facts could
t be closer than they are to the case at bar. The Dis-
ct Court has been called upon to exercise its judgment
d discretion as to all of these things and has passed
on them as shown in his opinion (Appendix A) and
at is said in the *Wagner* case should control.

"Mandamus is an extraordinary remedy, to be resorted to for the purpose of securing judicial action, not for determining in advance what that action shall be. * * * It may not be resorted to * * * for the purpose of controlling minor orders made in the conduct of judicial proceedings, and the fact that the result of litigation may possibly be such that interlocutory proceedings taken may not prove of value is not a sufficient reason for calling the writ into use for the purpose of forbidding such proceedings even though the cost of them cannot be recovered from the opposing party or even though the order cannot be reversed on error or appeal."

VII.

THE EXTRAORDINARY REMEDY OF PROHIBITION WILL LIE ONLY TO REVIEW WANT OF JURISDICTION IN A LOWER COURT. IT WILL NOT LIE TO REVIEW THE EXERCISE OF A JUDICIAL FUNCTION BY AN INFERIOR TRIBUNAL, NOR IS A MOTION OF THIS KIND PROPER.

As we have heretofore shown the Court of Appeals, and therefore *a fortiori* this court, never secured jurisdiction over the accounting proceeding pending in the District Court and the record therein has never been removed therefrom or affected by any writs or processes of either of the appellate tribunals. Therefore the accounting is not now pending before this court and it follows that this court has no power to issue a writ of prohibition to the District Court because the issuance of such a writ would not be in aid of its appellate jurisdiction.

In re Massachusetts, 197 U. S. 482,

In re Glaser, 198 U. S., 161.

This court is limited by Sec. 234 of The Judicial Code to issue writs of prohibition as original process in admiralty and maritime cases only.

Ex parte Graham, 10 Wall. 541.

This court has laid down the rule in no uncertain terms that a writ of prohibition is never to be issued unless it clearly appears that the inferior court is about to exceed its jurisdiction. It cannot be made to serve the purpose of a writ of error or certiorari to correct mistakes of that court in deciding any question of law or fact within its jurisdiction.

Re Detroit River Ferry Co., 104 U. S., 519.

Moran v. Sturges, 154 U. S., 256.

It will issue to review cases of want of jurisdiction of either the subject-matter or of the parties—in such cases only.

Morrison v. District Court, 147 U. S., 14.

There is nothing in the decision relied on by counsel for petitioner,

Bromson v. La Crosse, etc. Ry. Co., 1 Wall., 405,

that in any wise conflicts with the aforesaid propositions. In that case this court intimated that it might issue a writ if the District Court further continued to act in a proceeding after it had lost jurisdiction thereover because

of the creation of the Circuit Court and the transfer to it of the jurisdiction of the subject-matter previously held by the District Court. It further appears in that case that the appellant who had taken an appeal from a decree also sought to enforce it pending such appeal, a manifestly inconsistent position. The decision, however, is primarily and fundamentally based on a total want of jurisdiction by the District Court.

It is further respectfully submitted that if this court is to entertain this proceeding at all it should be done on verified petition filed only after leave of court has been obtained and a hearing had after rule to show cause has been entered herein, and none of these prerequisites have been taken.

VIII.

PETITIONER WILL NOT BE BENEFITTED BY THE STAYING OF THE ACCOUNTING, BUT ON THE CONTRARY, RESPONDENTS WILL BE IRREPARABLY DAMAGED THEREBY.

The equities of the situation are all with respondents. The accounting is all but completed. The expense of the accounting work necessary to complete the computations is small.

In view of the decisions in force in the seventh circuit, e. g.,

Western Glass Co. v. Schmertz, 226 Fed., 730, 738 (C. C. A., 7th Cir.)

Schmertz v. Western Glass Co., 236 Fed., 744 (C. C. A., 7th Cir.)

respondent's right to recover interest on the award of profits is extremely doubtful until the computation has been completed and embodied in the master's report. This loss of interest is great and irreparable. The figures of the accountants so far as worked out in conformity with the master's ruling indicate that the award is in the neighborhood of $450,000, and this is for profits only. Interest on this amount is approximately $87 per day and respondents are in grave danger of losing, nay, already for many days have lost, this interest which in equity and good conscience belongs to them, because of the dilatory tactics of petitioner in preventing the completion of the work, and for this loss respondents are apparently remediless.

The situation as regards the merits of the granting or withholding of the stay as affecting the accounting is exactly the same situation that was presented to both the District Court and the Circuit Court of Appeals on the motions for stay. They weighed in the scales against the cost of completing the accounting to the petitioner, the immense and irreparable loss of interest that would accrue to respondents, and could come to but one conclusion.

There is this difference: that at present the accounting is practically complete before the master, entirely in fact except the computation to be done by certain accountants, whereas at the time these motions were made below there was months of litigation yet to be completed.

We submit that since both lower courts have been called upon to exercise their discretion in this matter and have decided adversely to petitioner, that this court should not on a summary application for an extraordinary writ overrule their decisions.

IX.

CONCLUSION.

For the reasons stated respondents respectfully submit that the only proceeding of which this court has jurisdiction was the suit commenced in the Court of Appeals by original petition, that it is not a case arising out of the patent laws, that no emergency has been shown affecting petitioner, that the writ of certiorari is not *ipso facto* a stay to the District Court, and that the equities are all with respondents.

Respectfully submitted,

JOSEPH B. COTTON,
WILLET M. SPOONER,
WILLIAM R. RUMMLER,
LOUIS QUARLES,
Solicitors and of Counsel for Respondents.

APPENDIX "A".

OPINION OF JUDGE GEIGER REFUSING STAY.

UNITED STATES DISTRICT COURT.
Eastern District of Wisconsin.

Neils A. Christensen, *et al*,
Plaintiffs,
vs.
National Brake & Electric Company,
Defendant.

September 19, 1919.

The defendant has made an application for a stay of further proceedings under the judgment in this case, because the Supreme Court has granted a certiorari to the Circuit Court of Appeals to review the latter's refusal to entertain a petition there filed. I shall state briefly my reasons for denying the motion:

The judgment in this case was appealed to the Circuit Court of Appeals, affirmed, and upon application, the Supreme Court declined to grant a certiorari. Three years later an application was made in this court for leave to amend the defendant's answer by setting up a contrary adjudication, said to be final, in the Third Circuit, and praying for a dismissal of the bill and pending accounting proceedings before the master. Such motion was denied.

Thereupon the defendant filed in the Circuit Court of Appeals for this circuit, a petition asking that the mandate issued upon appeal three years ago be recalled, vacated, and directions given to this court for dismissal of the bill and pending accounting proceedings. The Circuit Court of Appeals denied such petition, and the Supreme Court has granted a certiorari to review such ruling. It is now urged that because of the issuance of such certiorari, this court should stay the proceedings pending determination in the ultimate court.

It may be conceded as quite elementary that ordinarily the issuance of a writ of certiorari carries with it a supersedeas. But I cannot escape the conviction that the judgment which is the subject of the present proceedings in this court, is not at all affected, either by the petition filed in the Circuit Court of Appeals, nor by the certiorari issued by the Supreme Court. Such petition, filed three years after the Circuit Court of Appeals had exhausted its appellate jurisdiction,—and the latter was the only jurisdiction ever invoked,—is clearly of the na-

ture of an original proceeding, and, in my judgment, particularly in view of the refusal of the Court of Appeals to grant the relief prayed for, reaches neither the judgment nor this court.

The learned counsel for the defendant, in attempting to meet this view of the case, says:

> "If the Circuit Court of Appeals on our application had ruled the other way, had held the decree of the Wisconsin Court interlocutory, and that of the Pennsylvania Court final, had acceded to our request and instructed this court to vacate the reference or the order for the accounting, to vacate its decree holding 635280 a valid patent, and to dismiss the bill, or to do any one or more of these things, and the plaintiffs Christensen, *et al.*, had sought and obtained a certiorari from the Supreme Court, could there be any question that by that certiorari these affirmative acts, which this court had been instructed to perform, would have been stayed until the Supreme Court had decided the case? What is the difference in reason and essence between this and the proper effect of a certiorari obtained by us to stay proceedings on the account and in subsequent steps?"

In my judgment, the very clear difference is that in the one case the jurisdiction of the Appellate Court, whether it be original or otherwise, would in fact be exerted against the decree in process of enforcement by this court, and the judgment of the Appellate Court would reach this court as much as any process ever could. But the Court of Appeals declined not only to so direct this court, but declined to do the very thing which was essential, namely, to recall its own mandate which is still operative on this court; and that is true whether the decree is final or interlocutory. In such situation, the certiorari from the Supreme Court to the Circuit Court of Appeals affects merely the refusal of the latter, in an original proceeding to take to its jurisdiction the judgment *not then before it*. It has refused to do the thing prayed for,—recall its former mandate, now binding and operative against this court. It has seemed to me that whatever the character of the petition filed in the Court of Appeals, the situation in this court so far as affected by that petition and its attempted review by the Supreme Court, is no different than if the declared purpose had been to obtain leave of the Court of Appeals to file a sup-

plemental bill in the nature of a bill of review in this court,—based upon the proceedings in the Third Circuit. If in such situation the Appellate Court refused leave, it could hardly be said that a certiorari to its ruling reached the judgment which, under the original mandate then rested in the District Court for exclusive enforcement. This distinction would seem to be observed in *Waskey v. Hammer*, 179 Fed., 273, where, notwithstanding the refusal of the Appellate Court to recall its mandate, the certiorari of the Supreme Court was expressly *directed* to and therefore brought up *the very judgment* which had been the subject of the *appellate jurisdiction;* and so long as the jurisdiction of the Supreme Court was thus exerted, the certiorari commanded respect as a supersedeas from every court where such judgment was lodged for enforcement.

For this reason the motion for .. stay will be denied.

(Signed) F. A. GEIGER,
District Judge.

Filed September 19, 1919.